



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,779	07/03/2000	MARKUS POMPEJUS	48715	2744

7590

02/02/2002

KEIL & WEINKAUF  
1101 CONNECTICUT AVENUE NW  
WASHINGTON, DC 20036

EXAMINER
----------

LOEB, BRONWEN

ART UNIT	PAPER NUMBER
----------	--------------

1636

16

DATE MAILED: 02/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/582,779

Applicant(s)

POMPEJUS ET AL.

Examiner

Bronwen M. Loeb

Art Unit

1636

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 24 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
**REMY YUCEL, PH.D**  
**PRIMARY EXAMINER**

## Continuation of 2. NOTE:

While Applicant's amendments to claim 2 and 10 would overcome the rejection of claim 2 under 35 USC §112, second paragraph and the objection to claim 10, the amendments do not serve to put the case in better shape for appeal.

Applicant's proposed amendments to claims 1 and 2 do not overcome the rejection under 35 USC §101 for two reasons. First, it is not clear in claims 1 and 2 whether only the homologs are isolated from microorganisms or whether the gene having SEQ ID No.1 is also isolated (the latter would need to be true to overcome the §101 rejection). Thus, entering the amendment would not overcome the 35 USC §101 rejection and would also raise the possibility of a rejection under 35 USC §112, second paragraph. Secondly, claims 3 and 4 have not been amended to claim "an isolated amino acid sequence" therefore these claims still read on a product of nature.

With respect to the rejection of claims 1-15 under 35 USC §112, first paragraph (written description), Applicant has argued that since the sequence of SEQ ID No. 1 is disclosed, the sequence of homologs having at least 80% homology is also disclosed because one of skill in the art would know how to make changed by genetic engineering to yield homologs that do not affect the activity of the corresponding protein. This is not persuasive because one of skill in the art would only know how to make such changes if a structure-function correlation were taught in the specification. Specifically, there are no teachings of what sequences correspond to the active site of the enzyme, the binding pocket of the enzyme or the hydrophobic core of the enzyme. Absent these critical structure-function teachings, it is clear that Applicant did not have possession of homologs which have 80% homology to SEQ ID No. 1. Consequently, Applicant's argument has not overcome the rejection of claims 1-15 under 35 USC §112, first paragraph.

It is noted that there appears to a misspelling of Inventor Revuelta's name on the filing receipt, in addition to the incorrect filing date for the PCT parent. Also, in the specification, on p. 3, lines 30-31, there appears to be a typographical error. The amino-acid sequence deduced from the nucleotide sequence SEQ ID No. 1 is SEQ ID No.2.